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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,541	10/15/2001	Kaneyoshi Hayashi	SHO1005-01US	6752

28327 7590 02/11/2004

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EXAMINER

RAJGURU, UMAKANT K

ART UNIT PAPER NUMBER

1711

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,541

Applicant(s)

HAYASHI, KANEYOSHI

Examiner

Umakant K. Rajguru

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 & 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1711

1. A response has been filed on October 21, 2003.
2. Claims being examined are 1-8, 11, and 13.
3. Rejection of claim 13 (see item 4 of office action of June 19, 2003) is now withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yau, S. (USP 5080942).
6. Claims 1-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau, S. (USP 5080942).
7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yau, S. (USP 5080492) as applied to claims 1 and 2 above, and further in view of Patel, R (USP 4654402).

Please refer to prior office action of June 19, 2003 for these rejections.

8. Applicant's arguments filed October 21, 2003 have been fully considered but they are not persuasive. On page (5 of above response) the applicant states that <sup>a</sup>Y~~ou~~ pertained to use of carbon black and not while carbon ". This statement is not persuasive because Yau. in col. 2, line 37 and in col. 7, line 7-8 uses silica which is white carbon.

Submitted declaration has been considered.

In appendix B of the declaration is a table having two examples X and Y. Sample X has same composition as example 1 of instant specification. Samples X & Y are

Art Unit: 1711

prepared to show effect of presence of carbon black, on the hardness, weight change and thereby resistance to chlorine of the molded product. It is not clear why polybutene, clay and silane coupler (which are present in sample X) are missing in sample Y. Also why is processing oil added in sample Y (when it is absent in sample X)? Data on these samples are therefore not helpful to arrive at any specific conclusions.

There is no comparative information of any experimental work done based on teachings of primary reference viz Yau. Furthermore instant claims do not encompass limitation of hardness, weight change and chlorine resistance. Additionally the recitation "consisting essentially of" fails to exclude additional moieties of Yau unless the applicant furnishes evidence that those moieties affect the basic & novel characteristics of instantly claimed invention.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 1711

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru, whose telephone number is (571) 272-1077. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

~~Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.~~

  
U.K. Rajguru/af  
February 4, 2004

  
James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1711